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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty Docket No.: 2401.146.US

In re the Patent application of

David C. Hacker et al

Petition Examining Attorney: Paul Shanoski

Serial No.: 10/754,493

Group Art Unit: 3736

Filed: January 12, 2004

For: Apparatus and Method for Intraoperative Neural Monitoring

RENEWED PETITION UNDER 37 CFR § 1.47

MAIL STOP: PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This renewed petition is submitted in response to the Decision on Petition Under 37 CFR § 1.47(a) dated May 31, 2005.

As explained in the Decision on Petition Under 37 CFR §1.47(a), Applicants' original Petition was not granted because the evidence submitted with the original petition failed to establish, to the satisfaction of the Petition Examining Attorney, that a complete copy of the application papers was sent to the legal representative of the deceased non-signing inventor and because the Declaration sent to the legal representative of the deceased non-signing inventor failed to contain the last known address of the deceased inventor as well as the citizenships of the deceased inventor and his legal representative. The aforementioned deficiencies are believed to be satisfied by this renewed petition.

The following documents are submitted herewith in support of this renewed

petition:

Exhibit A: Copy of a letter dated July 8, 2005 from Trevor D. Arnold, Senior Patent Counsel for Medtronic Sofamor Danek, Inc., to Katherine M. Rupp;

Exhibit B: Copy of Supplemental Declaration enclosed with the letter of Exhibit A including Declaration Supplemental Sheet For Legal Representatives (35 U.S.C. 117) On Behalf of a Deceased or Incapacitated Inventor and Declaration For Utility or Design Patent Application (37 CFR 1.63) with two pages of Additional Inventor(s) Supplemental Sheets;

Exhibit C: Copy of certified mail receipts pertaining to the mailing of Exhibit A and its enclosures to Katherine Rupp;

Exhibit D: Copy of the front face of the envelope in which Exhibit A and its enclosures were mailed to Katherine Rupp and bearing the stamp of the U.S. Postal Service showing the mailing was unclaimed or refused; and

Exhibit E: Copy of certified mail receipts pertaining to the mailing of Exhibit A and its enclosures to Katherine Rupp's legal representative.

Exhibit A is a letter from Trevor D. Arnold, Senior Patent Counsel for Medtronic Sofamor Danek, Inc., to Katherine M. Rupp, the legal representative of the deceased non-signing inventor, Lionel Rupp. Katherine Rupp's status as legal representative for Lionel Rupp was established in Applicants' original petition. The letter of Exhibit A demonstrates that a complete copy of the application papers for the subject patent application, including the specification, claims, drawings and a Supplemental Declaration, were sent to Katherine Rupp with a request that she review the application and sign and date the Supplemental Declaration as the legal representative of Lionel

Rupp. Exhibit A shows that the subject letter and its enclosures were sent to Katherine Rupp via certified mail, and further shows that copies of the subject letter and its enclosures were sent to Donald Farinacci, Katherine Rupp's legal representative, via certified mail. Donald Farinacci's status as legal representative for Katherine Rupp was established in Applicants' original petition.

Exhibit B is a copy of the Supplemental Declaration referred to and enclosed with the letter of Exhibit A sent to Katherine Rupp and her legal representative. The Supplemental Declaration consists of a Declaration Supplemental Sheet For Legal Representatives(35 USC 117) On Behalf of A Deceased or Incapacitated Inventor setting forth Katherine Rupp's name, residence, mailing address and citizenship, and the original Declaration For Utility Or Design Patent Application (37 CFR 1.63) executed by the other co-inventors with page 2 of the Additional Inventor(s) Supplemental Sheet revised to include the last known address and citizenship for Lionel Rupp. A removable "sign and date" label was affixed to the Declaration Supplemental Sheet to identify the boxes for Katherine Rupp to insert the date and her signature.

Exhibit C is a copy of the certified mail receipts of the U.S. Postal Service pertaining to the mailing of Exhibit A and its enclosures to Katherine Rupp via certified mail, return receipt requested.

Exhibit D is a copy of the front face of the envelope in which Exhibit A and its enclosures were mailed to Katherine Rupp via certified mail, return receipt requested, and bears the stamp of the U.S. Postal Service establishing that the mailing was returned to Medtronic Sofamor Danek on July 25, 2005 as being unclaimed or refused by Katherine Rupp.

Exhibit E is a copy of the certified mail receipts of the U.S. Postal Service pertaining to the mailing of Exhibit A and its enclosure to Donald Farinacci, Katherine Rupp's legal representative at Fischbein, Badillo, Wagner and Harding. Exhibit E establishes that the mailing sent to Donald Farinacci was received and signed for on July 14, 2005. To date, no response has been received from Donald Farinacci on behalf of Katherine Rupp.

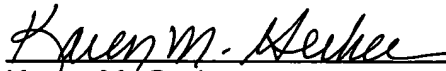
The evidence presented by this renewed petition establishes that a complete copy of the application papers for the subject patent application was sent to both Katherine Rupp and her legal representative with a request for execution of the Supplemental Declaration by Katherine Rupp as legal representative for the deceased non-signing inventor, Lionel Rupp. The evidence presented by this renewed petition further establishes that the application papers sent to Katherine Rupp and her legal representative included a Supplemental Declaration in conformance with 37 CFR §1.63 and that Katherine Rupp has refused to execute the Supplemental Declaration by virtue of her refusal to accept the application papers. Accordingly, the evidence provided by this renewed petition addresses and overcomes the deficiencies found by the Petition Examining Attorney in Applicants' original petition.

Since the petition fee under 37 CFR §1.47 has already been paid in connection with the original petition, no additional petition fee should be due in connection with this renewed petition. If, however, an additional petition fee is found to be required, authorization is hereby granted to charge such fee to Deposit Account No. 50-0449. A petition for a two month extension of time for responding to the Decision on Petition under 37 CFR §1.47(a) is submitted herewith along with the required extension of time

fee.

In light of the foregoing, it is respectfully requested that this petition be granted and that the Supplemental Declaration submitted herewith be accepted pursuant to 37 CFR §1.47(a).

Respectfully submitted,



Karen M. Gerken
Registration No. 31,161

EPSTEIN & GERKEN
1901 Research Boulevard, Suite 340
Rockville, Maryland 20850
(301) 610-7634

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: MAIL STOP: PETITIONS, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on September 26, 2005.

Ann L. Shebovsky



Medtronic Sofamor Danek
1800 Pyramid Place
Memphis, TN 38132
www.medtronic.com

tel 800.876.3133

COPY

Via Certified Mail

July 8, 2005

Katherine M. Rupp
27 Belver Drive
Bohemia, NY 11716

Re: US Patent Application No.: 10/754,493
Title: Apparatus and Method for Intraoperative
Neural Monitoring
Our Docket No.: PD251.00

Dear Ms. Rupp:

Enclosed please find a complete copy of the above-referenced patent application as filed with the USPTO on January 12, 2004, including the specification, claims and drawings. A Supplemental Declaration is also enclosed. We ask that you please review the application and sign and date the Declaration Supplemental Sheet as the legal representative of Lionel Rupp. Please do so by July 22, 2005 and return the fully executed documents to me in the pre-addressed and stamped envelope enclosed. The Supplemental Declaration consists of the Declaration Supplemental Sheet for Legal Representatives and the original Declaration executed by the other co-inventors, but with a revised page 2 of the Additional Inventor(s) Supplemental Sheet which includes that last known address for Lionel Rupp. The Declaration Supplemental Sheet indicates that you are a United States citizen. If, however, you are not a U.S. citizen, please indicate your correct country of citizenship on the Supplemental Declaration.

Thank you for your assistance in this matter.

Sincerely,

A handwritten signature in black ink, appearing to read "T. Arnold", written over a horizontal line.

Trevor D. Arnold
Sr. Patent Counsel

/jtm
Enclosures
cc: Donald Farinacci (w/encl.via certified mail)

When Life Depends on Medical Technology

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION Supplemental Sheet

For Legal Representatives (35 U.S.C. 117) On Behalf of A Deceased or Incapacitated Inventor

Enter Deceased or Incapacitated Inventor's Name Lionel Rupp

Page 1 of 1

**SIGN
& DATE**

Name of Legal Representative:		<input checked="" type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Katherine M.		Rupp	
Legal Representative's Signature		Date	
Residence: City	Bohemia	State	NY
		Country	US
Citizenship US			
Mailing Address 27 Belver Drive			
Mailing Address			
City		State	NY
		Zip	11716
		Country US	
Name of Additional Legal Representative, if any:		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Legal Representative's Signature			
Residence: City		State	
		Country	
Citizenship			
Mailing Address			
Mailing Address			
City		State	
		Zip	
		Country	
Name of Additional Legal Representative, if any:		<input type="checkbox"/> A petition has been filed for this non-signing legal representative	
Given Name (first and middle (if any))		Family Name or Surname	
Legal Representative's Signature		Date	
Residence: City		State	
		Country	
Citizenship			
Mailing Address			
Mailing Address			
City		State	
		Zip	
		Country	

This collection of information is required by 35 U.S.C. 117 and 37 CFR 1.42, 1.43, 1.63 and 1.64(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Please type a plus sign (+) inside this box → ☐

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Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**DECLARATION FOR UTILITY OR
DESIGN
PATENT APPLICATION
(37 CFR 1.63)**

☒ Declaration Submitted with Initial Filing OR ☐ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)

Attorney Docket Number	2401.146.US
First Named Inventor	David C. Hacker
COMPLETE IF KNOWN	
Application Number	/
Filing Date	
Group Art Unit	
Examiner Name	

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Apparatus and Method for Intraoperative Neural Monitoring

the specification of which

☒ is attached hereto
OR

☐ was filed on (MM/DD/YYYY) as United States Application Number or PCT International

Application Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)	<input type="checkbox"/> Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.
60/441,471	01/22/2003	

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box → ☐

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DECLARATION — Utility or Design Patent Application

I hereby claim the benefit under 35 U.S.C. 120 of any United States application(s), or 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application or PCT Parent Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number (if applicable)

☐ Additional U.S. or PCT international application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

As a named inventor, I hereby appoint the following registered practitioner(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

☐ Customer Number OR ☒ Registered practitioner(s) name/registration number listed below

Place Customer Number Bar Code Label here

Name	Registration Number	Name	Registration Number
Robert H. Epstein	24,353		
Karen M. Gerken	31,161		

☐ Additional registered practitioner(s) named on supplemental Registered Practitioner Information sheet PTO/SB/02C attached hereto.

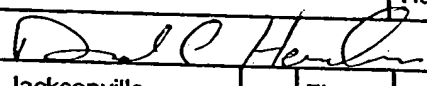
Direct all correspondence to: ☐ Customer Number or Bar Code Label OR ☒ Correspondence address below

Name	Robert H. Epstein				
Address	Epstein & Gerken				
Address	1901 Research Blvd., Suite 340				
City	Rockville	State	MD	ZIP	20850
Country	U.S.	Telephone	(301) 610-7634	Fax	(301) 610-9569

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor: ☐ A petition has been filed for this unsigned inventor

Given Name (first and middle [if any])	Family Name or Surname
David C.	Hacker

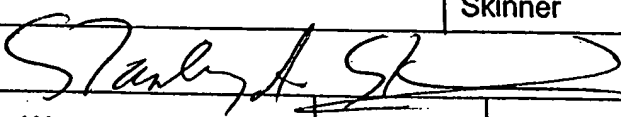
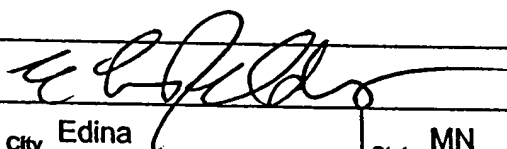

Inventor's Signature				Date	12/30/00
Residence: City	Jacksonville	State	FL	Country	US
Post Office Address	818 Old Grove Manor				
Post Office Address					
City	Jacksonville	State	FL	ZIP	32207
				Country	US

☐ Additional inventors are being named on the _____ supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto

Please type a plus sign (+) inside this box → ☐

PTO/SB/02A (11-00)
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DECLARATION	ADDITIONAL INVENTOR(S) Supplemental Sheet Page <u>1</u> of <u>2</u>
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Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle (if any))		Family Name or Surname					
Stanley A.		Skinner					
Inventor's Signature 		Date <u>1/5/04</u>					
Residence: City	Wayzata	State	MN				
		Country	US				
Citizenship				US			
Mailing Address				183 Whitegate Lane			
Mailing Address							
City	Wayzata	State	MN	ZIP	55391	Country	US
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle (if any))		Family Name or Surname					
Ensor E.		Transfeldt					
Inventor's Signature 		Date <u>12/29/03</u>					
Residence: City	Edina	State	MN				
		Country	US				
Citizenship				US			
Mailing Address				13 Paddock Road			
Mailing Address							
City	Edina	State	MN	ZIP	55424	Country	US
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor					
Given Name (first and middle (if any))		Family Name or Surname					
Peter P.		Sterrantino					
Inventor's Signature 		Date <u>12/29/03</u>					
Residence: City	JACKSONVILLE	State	FL				
		Country	USA				
Citizenship				US			
Mailing Address				1832 GRASSINGTON WAY N.			
Mailing Address							
City	JACKSONVILLE	State	FL	ZIP	32223	Country	USA

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DECLARATION

ADDITIONAL INVENTOR(S)

Supplemental Sheet

Page 2 of 2

Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Lionel		Rupp	
Inventor's Signature		Date	
Residence: City Jacksonville	State FL	Country US	Citizenship US
Mailing Address 7932 Southside Blvd, Apt 509			
Mailing Address			
City Jacksonville	State FL	ZIP 32256	Country US
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
Mailing Address			
City	State	ZIP	Country
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
Mailing Address			
City	State	ZIP	Country

Burden Hour Statement: This form is estimated to take 21 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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City, State, ZIP+4 Bohemia NY 11716

PS Form 3800, June 2002

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C. Signature ☒ Agent ☐ Addressee

D. Is delivery address different from item 1? ☐ Yes ☐ No
If YES, enter delivery address below:

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☐ Insured Mail ☐ C.O.D.
Restricted Delivery? (Extra Fee) ☐ Yes

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- Print your name and address on the reverse so that we can return the card to you.
- Attach the card to the back of the mailpiece, or on the envelope if space permits.

1. Article Addressed to:

~~Katherine Rust
27 Belver Drive
Bohemia NY 11716~~

2. Article Number (Copy from serv)

7004 0750 0000 2434 2653

PS Form 3811, July 1999

Domestic Return Receipt

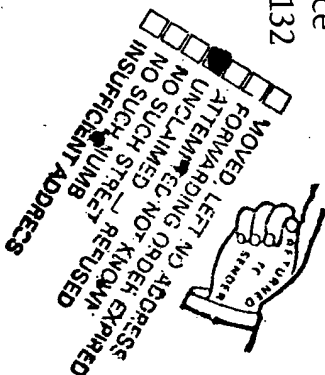
102595-00-M-0952

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SOFAMOR DANEK

Medtronic Sofamor Danek
1800 Pyramid Place
Memphis, TN 38132



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RETURNED 3:25

~~Katherine M. Rupp
27 Belver Ave
Bohemia, NY 11716~~



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Signal, A/C No. Fischbein, Badillo et al.
or PO Box No. 99 Third Ave. NY, NY 10022
City, State, ZIP+4

PS Form 3800, June 2002

See Reverse for Instructions

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- Print your name and address on the reverse of this card and attach to the back of the mailpiece.
- Attach this card to the back of the mailpiece.
- 1. Article Addressed to: ARTICLE 12-2005

MEDTRONIC SOFTWARE DANEC
CONTRACT DEPT. 12-2005

Fischbein, Badillo et al.
99 Third Ave.
NY NY 10022

COMPLETE THIS SECTION ON DELIVERY

A. Received by (Please Print Clearly) D. Sivil B. Date of Delivery 7/14/05
C. Signature D. Sivil ☐ Agent ☐ Addressee
D. Is delivery address different from item 1? ☐ Yes ☐ No
If YES, enter delivery address below:

3. Service Type
☒ Certified Mail ☐ Express Mail
☐ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.
4. Restricted Delivery? (Extra Fee) ☐ Yes

95-00-M-0952

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